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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,789	08/14/2001	Michael A. Tischler	2771-161-CON	1145
25559	7590	03/11/2004	EXAMINER	
ATMI, INC. 7 COMMERCE DRIVE DANBURY, CT 06810			SONG, MATTHEW J	
			ART UNIT	PAPER NUMBER
			1765	

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/929,789

Applicant(s)

TISCHLER ET AL.

Examiner

Matthew J Song

Art Unit

1765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-76 is/are pending in the application.
- 4a) Of the above claim(s) 39-60, 62, 68, 69 and 72-76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61, 63-67, 70 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 61, 63-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akasaki et al (US 4,855,249) in view of Gmitter et al (US 4,883,561) or in view of Bozler et al (US 4,837,182).

Akasaki et al discloses a method of growing a single crystalline, hetero-epitaxial $\text{Al}_x\text{Ga}_{1-x}\text{N}$ film on a sapphire substrate (Abstract). Asasaki et al also discloses forming GaN and using an AlN buffer layer (claim 1 and col 4, ln 40-55).

Akasaki et al does not teach removing the heterogeneous substrate to yield a single crystal substrate.

Art Unit: 1765

In a method of removing a substrate, note entire reference, Gmitter et al teaches removing an epitaxial layer from a single crystal substrate by providing a thin release layer between the film and the single crystal substrate and selectively etching the release layer (Abstract and claims 1-2). Gmitter et al also teaches the epitaxial growth of GaAs on sapphire and other III-V compounds should be useable with invention (col 10, ln 15-50). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Akasaki et al method of depositing a GaN, III-V semiconductor, on a sapphire substrate with Gmitter et al method of removing a III-V semiconductor from a sapphire substrate so that the substrate can be reused (col 1, ln 5-25), thereby reducing costs.

In a method of removing a substrate, note entire reference, Bozler et al teaches forming a mask on a substrate to expose single crystal areas, depositing a crystallizable material over the substrate and mask and separating the crystalline material from the substrate and optionally reusing the substrate (claims 1-2). Bozler et al also teaches the crystallizable material can be preferentially etched, melted, sublimed, cleaved or otherwise removed to separate the sheet of crystalline material from the substrate (col 6, ln 50-65). Bozler et al also teaches GaAs is a suitable substrate and a carbonized photoresist mask **12** (col 7, ln 5-55). Bozler et al also teaches gallium arsenide, silicon, and other semiconductors or their associated alloys can be employed in the fabrication of sheets of crystalline materials (col 26, ln 25-55). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Akasaki et al method of depositing a GaN, a semiconductor, on a substrate with Akasaki et al's method of removing a semiconductor from a substrate so that the substrate can be reused, thereby reducing costs ('182 col 6, ln 65 to col 7, ln 5).

Art Unit: 1765

Referring to claims 64-67, the combination of Akasaki et al and Gmitter et al or the combination of Akasaki et al and Bozler et al teach an intermediate layer of a mask or an AlN buffer. The combination of Akasaki et al and Gmitter et al or the combination of Akasaki et al and Bozler et al is silent to the intermediate layer includes a template layer, a protective layer or an etch stop layer. However, these limitations are considered to be intended use limitations and a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the claimed intended use, then it meets the claim. The mask and AlN layer taught would inherently be capable of performing the claimed intended use.

3. Claims 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akasaki et al (US 4,855,249) in view of Gmitter et al (US 4,883,561) or in view of Bozler et al (US 4,837,182) as applied to claims 61 and 63-67 above, and further in view of Manasevit (US 3,922,475).

The combination of Akasaki et al and Gmitter et al or the combination of Akasaki et al and Bozler et al teach all of the limitations of claim 70, as discussed previously, including a GaN on a sapphire substrate. The combination of Akasaki et al and Gmitter et al or the combination of Akasaki et al and Bozler et al does not teach a GaAs substrate.

In a method of producing nitride films, note entire reference, Manasevit teaches single crystal gallium nitride films can be grown on sapphire substrates or gallium arsenide substrates (col 1, ln 45-55). It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Akasaki et al and Gmitter et al or the combination of

Art Unit: 1765

Akasaki et al and Bozler et al by using a GaAs substrate, as taught by Manasevit, because substitution of known equivalent for the same purpose is held to be obvious (MPEP 2144.06).

Referring to claim 71, the combination of Akasaki et al, Manasevit and Gmitter et al or the combination of Akasaki et al, Manasevit and Bozler et al teach removing the substrate by preferentially etching. The combination of Akasaki et al, Manasevit and Gmitter et al or the combination of Akasaki et al, Manasevit and Bozler et al is silent to the temperature at which etching occurs. Temperature is well known in the art to be a result effective variable. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Akasaki et al, Manasevit and Gmitter et al or the combination of Akasaki et al, Manasevit and Bozler et al by optimizing the temperature by conducting routine experimentation of a result effective variable (MPEP 2144.05). Furthermore, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. (In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235(CCPA 1955)).

Terminal Disclaimer

4. The terminal disclaimer filed on 12/15/2003 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US 5,679,152 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

Art Unit: 1765

5. The double patenting rejection over Tishcler et al (US 5,679,152) has been withdrawn because of the properly filed terminal disclaimer.
6. The rejections in view of Akasaki et al (US 5,846,844) have been withdrawn because of a properly filed Declaration showing conception prior to the effective date of Akasaki.
7. Applicant's arguments with respect to claims 61, 63-67 and 70-71 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Edmonds (US 3,806,777) teaches gallium nitride is a useful substrate for making light emitting PN junctions (col 3, ln 5-20).

Hasegawa et al (US 4,168,998) teaches removing wafers from a substrate by using a carbonaceous powder (Abstract).

JP 52-103399 teaches overgrowth of GaN on a silicone base (English Abstract).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Song whose telephone number is 571-272-1468. The examiner can normally be reached on M-F 9:00-5:00.

Art Unit: 1765

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571-272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew J Song
Examiner
Art Unit 1765

MJS

NADINE G. NORTON
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Nadine', with a long horizontal flourish extending to the right.